

REMARKS

The present application includes pending claims 1-33, all of which have been rejected. The specification has been amended to include the serial number for an application that the present application incorporates by reference (Paragraph [0013]), and to correct a minor typographical error (Paragraph [0045]). Claims 12, 16, and 25 have been amended as set forth above. The Applicants respectfully submit that the claims define patentable subject matter.

I. The Claims Limit The Subject Matter And Are Definite

Claims 3, 4, 18, and 27 were objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 1 recites, in part, "at least one internal elastic buffer." Claim 2 adds that the "at least one elastic buffer comprises at least one of a receive internal elastic buffer and a transmit internal elastic buffer." Claim 3 adds the limitation that the "at least a portion of said incoming TCP packet is temporarily buffered in said receive internal elastic buffer," while claim 4 includes the limitation that "at least a portion of a TCP packet to be transmitted is temporarily buffered in said transmit internal elastic buffer." Therefore, the Applicants respectfully submit that claims 3 and 4 further limit claim 2 by stating where the TCP packet is buffered in particular. Claims 18 and 27 add similar limitations. Thus, the Applicants respectfully request reconsideration of these claim objections.

Claims 12, and 16-33 were rejected under 35 U.S.C 112, second paragraph, as being indefinite due to the use of various acronyms. The Applicants have amended these claims to overcome this rejection.

II. Claims 1-33 Are Novel And Nonobvious

Claims 1-5, and 7-33 stand rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent No. 6,757,746 ("Boucher"). Claim 6 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Boucher. The Applicants respectfully traverse these rejections at least for the following reasons:

A. The Rejection Of Claims 1-5, And 7-33 As Being Anticipated By Boucher

The Applicants first turn to the rejection of claims 1-5, and 7-33 as being anticipated by Boucher. Boucher relates to "protocol processing for information communicated between hosts such as computers connected to a network." Boucher at column 1, lines 47-50. The Office Action cites "ASIC 400 disclosed in Figure 21 of app. No. 09/464,283, USPN 6,427,173 incorporated by reference" as a TEEC. See August 19, 2005 Office Action at pages 3-4.

Boucher states that in "one specific embodiment, NI device 102 is the Intelligent Network Interface Card (NIC) of FIGS. 21 and 22 of U.S. patent application Ser. No. 09/464,283 [United States Patent No. 6,427,173 ("Boucher '173")] (the entire disclosure of Ser. No. 09/464,283 is incorporated... by reference). See Boucher at column 1, lines 22-25. Boucher '173 states that

“INIC card 200 includes a Physical Layer Interface (PHY) chip 2100, ASIC chip 400 and Dynamic Random Access Memory (DRAM) 460.” See Boucher ‘173 at column 24, lines 60-63. As noted above, the DRAM 460 is separate and distinct from the ASIC chip 400.

The ASIC chip 400 includes a sequencers block 2102 that includes a data synchronization buffer and a data assembly register.

ASIC chip 400 includes a Media Access Control (MAC) unit 402, a sequencers block 2102, SRAM control 442, SRAM 440, DRAM control 450, a queue manager 2103, a processor 470, and a PCI bus interface unit 468.... Sequencers block 2102 includes a transmit sequencer 2104, a receive sequencer 2105, and configuration registers 2106.

Id. at column 24, line 67 to column 25, line 13.

FIG. 22 is a more detailed diagram of receive sequencer 2105. Receive sequencer 2105 includes a data synchronization buffer 2200, a packet synchronization sequencer 2201, a **data assembly register 2202**, ...

Id. at column 25, lines 17-21 (emphasis added).

As shown above, the ASIC chip 400, which the Office Action cites as a TEEC, includes a data assembly register. Data is being assembled within the ASIC, which the Office Action assumes is the TEEC, by virtue of the fact that the ASIC includes a data assembly register. Thus, Boucher does not teach or suggest “processing occurring [by a TEEC] without reassembly,” as recited in the claims of the present application. At least for this reason, the Applicants respectfully submit that Boucher does not anticipate the claims of the present application.

Additionally, while Boucher '173 states that the receive sequencer 2105 includes a "data synchronization buffer 2200" (*See id.* at column 25, lines 19-20), it also states the following:

Receiver sequencer 2105 uses the buffers **in DRAM 460** to store incoming network packet data as well as status information for the packet.

Id. at column 26, lines 3-5 (emphasis added). As noted above, DRAM 460 is separate and distinct from the ASIC 400. The ASIC, however, does not include at least one internal elastic buffer, wherein the ASIC processes an incoming TCP packet once and temporarily buffers at least a portion of the incoming TCP packet in the internal elastic buffer. Instead, the receive sequencer 2105 uses the buffers in DRAM 460 to store incoming network packet data, as noted above. Boucher does not teach, nor suggest, a TEEC including at least one internal elastic buffer, wherein the TEEC processes an incoming TCP packet once and temporarily buffers at least a portion of said incoming TCP packet in said internal elastic buffer, as recited, for example, in claim 1 of the present application. Thus, at least for this reason, the Applicants respectfully submit that Boucher does not anticipate the claims of the present application.

B. Inherency

The Office Action states the following:

Claim 9 is rejected for similar reasons as stated above (i.e., it is inherent that any packet received would be inserted in its correct placement in host memory as shown by Figure 2).

See August 19, 2005 Office Action at page 5. Initially, the Applicants note that it appears that additional claims are being rejected based on inherency. That is, the Office Action cites that “claim 9 is rejected for similar reasons stated above ([that is,] it is inherent...)”.

The Applicants submit that a rejection based on inherency must include a statement of the rationale or evidence tending to show inherency. See Manual of Patent Examining Procedure at § 2112. “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” See *id. citing In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The Applicants respectfully submit that neither Boucher itself nor the Office Action “make[s] clear that the missing descriptive matter,” said to be inherent “is necessarily present in” Boucher.

A rejection based on inherency must be based on factual or technical reasoning:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

The Applicants respectfully submit that the Office Action does not contain a basis in fact and/or technical reasoning to support the rejection based on inherency. Instead, as recited above, at least claim 9 of the present application stands rejected based on a conclusory statement of inherency, rather than upon a “basis in fact and/or technical reasoning.” Accordingly, the Applicants respectfully submit that, absent a “basis in fact and/or technical reasoning” for the rejection of record, that rejection should be reconsidered and withdrawn.

C. Boucher Does Not Render Claim 6 Unpatentable

Claim 6 stands rejected as being unpatentable over Boucher. Initially, the Applicants respectfully submit that claim 6 should be in condition for allowance, at least for the reasons set forth above.

The Office Action states the following:

Boucher does not specifically state that only the elastic buffer is used to temporarily buffer at least a portion of the incoming TCP packet, however, it is well known that elastic buffers are used to buffer packets (i.e., receiving FIFO's for routers, etc.). By this rationale, “**Official Notice**” is taken that both the concept and advantages of providing for utilizing only the elastic buffer to temporarily buffer a portion of the TCP packet is well known and expected in the art.

See August 19, 2005 Office Action at page 6 (emphasis added).

The Applicants respectfully traverse the assertion of Official Notice as further set forth below. Alternatively, if the Examiner's assertion is based on the personal knowledge of the Examiner, then under MPEP § 2144.03(C) and 37

C.F.R. § 1.104(d)(2), the Examiner's assertions must be supported by an affidavit from the Examiner.

According to MPEP § 2144.03(A), Official Notice, without supporting references, should **only** be asserted when the subject asserted to be common knowledge is "capable of instant and unquestionable demonstration as being well-known." That is, the subjects asserted must be of "notorious character" under MPEP § 2144.03(A).

However, the Applicants respectfully submit that the subject matter of the assertion of Official Notice is not well-known in the art as evidenced by the searched and cited prior art. The Applicants respectfully submit that the Examiner has performed "a thorough search of the prior art," as part of the Examiner's obligation in examining the present application under MPEP § 904.02.

Additionally, the Applicants respectfully submit that the Examiner's searched and cited references found during the Examiner's thorough and detailed search of the prior art are indicative of the knowledge commonly held in the art. However, in the Examiner's thorough and detailed search of the relevant prior art, none of the prior art taught or suggested the subject matter of the assertion of Official Notice. That is, the Examiner's thorough and detailed search of the prior art has failed to yield any mention of the teaching that the Examiner is asserting is widely known in the art. The Applicants respectfully submit that if the subject matter of the assertion of Official Notice had been of "notorious character" and "capable of instant and unquestionable demonstration as being

well-known” under MPEP § 2144.03(A), then the subject matter would have appeared to the Examiner during the Examiner’s thorough and detailed search of the prior art.

If the Examiner had found any teaching of relevant subject matter, the Examiner would have been obligated to list the references teaching the relevant subject matter and make a rejection. Consequently, the Applicants respectfully submit that the prior art does not teach the subject matter of the assertion of Official Notice and respectfully traverses the assertion of Official Notice.

The Applicants specifically challenge the Examiner’s assertion of Official Notice with regard to claim 6 of the present application. As stated above, the Applicants respectfully traverse the assertion of Official Notice and submit that the subject matter is not of such “notorious character” that it is “capable of instant and unquestionable demonstration as being well-known.” Under MPEP 2144.03, the Examiner is now obligated to provide a reference(s) in support of the assertion of Official Notice if the Examiner intends to maintain any rejection based on the assertion of Official Notice. Additionally, the Applicants respectfully request the Examiner reconsider the assertion of Official Notice and provide to Applicants any basis for the assertion of Official Notice.

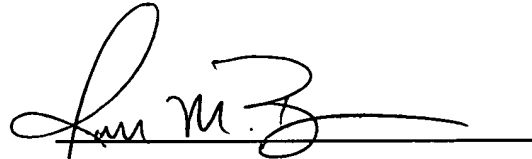
IV. Conclusion

The Applicants respectfully submit that the claims of the present application should be in condition for allowance at least for the reasons discussed above and requests that the outstanding rejections be reconsidered

and withdrawn. If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the Applicants. The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

Date: September 15, 2005

A handwritten signature in black ink, appearing to read "Joe M. Butscher", is written over a horizontal line.

Joseph M. Butscher

MCANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000
Facsimile: (312) 775-8100

Registration No. 48,326
Attorney for Applicant